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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/368,866	08/05/99	LINAS-BRUNET	13/068

HM12/0726

EXAMINER

ROBERT P. RAYMOND  
BOEHRINGER INGELHEIM CORPORATION  
900 RIDGEBURY ROAD PO BOX 368  
RIDGEFIELD CT 06877

OSWECKI, J

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 07/26/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/368,866**

Applicant(s)

**Linus-Brunet et al.**

Examiner

**Jane Oswecki**

Group Art Unit

**1626**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-86 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-86 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

Claims 1-86 are pending in the application.

#### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-65, drawn to compounds of formula (I) having no heterocyclic substituents in addition to the proline moiety, classified in class 548, subclass 400+ and class 562, subclass 433+.
- II. Claims 1-65, drawn to compounds of formula (I) having optionally substituted pyridinyl, benzopyridinyl, pyridinyloxy, benzopyridinyloxy and/or pyridinyl-methoxy groups alone or in combination with pyrazolyl, thiazolyl, thienyl, furanyl, indolyl and/or indolinyl groups in addition to the proline moiety, classified in class 546, subclass 249+.
- III. Claims 1-65, drawn to compounds of formula (I) having optionally substituted pyrimidinyl, pyrimidinyloxy, benzopyrimidinyloxy and/or benzopyrimidinyl groups alone or in combination with an imidazolyl group in addition to the proline moiety, classified in class 544, subclass 242+.
- IV. Claims 1-65, drawn to compounds of formula (I) having an optionally substituted morpholinyl group in addition to the proline and/or other heterocyclic moieties, classified in class 544, subclass 106+.

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- V. Claims 1-65, drawn to compounds of formula (I) having an optionally substituted piperidinyl or benzopiperidinyl group in addition to the proline and/or other heterocyclic moieties, classified in class 546, subclass 184+.
- VI. Claims 1-65, drawn to compounds of formula (I) having an optionally substituted piperazinyl group in addition to proline and/or pyridinyl moieties, classified in class 544, subclass 358+.
- VII. Claims 1-65, drawn to compounds of formula (I) having an optionally substituted pyrazinyl group alone or in combination with the proline moiety and/or pyridinyl and/or benzopyridinyl groups, classified in class 544, subclass 336+.
- VIII. Claims 73 and 80, drawn to a first process for preparing a compound of formula (I), classified in various classes and subclasses depending upon substituent moieties.
- IX. Claims 74 and 80, drawn to a second process for preparing a compound of formula (I), classified in various classes and subclasses depending upon the substituent moieties.
- X. Claims 75 and 80, drawn to a third process for preparing a compound of formula (I), classified in various classes and subclasses depending upon the substituents moieties.
- XI. Claims 76-79, drawn to compound intermediates, classified in classes 560 and 562, various subclasses depending upon the carboxy-protecting group.

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XII. Claim 81, drawn to a resolution process, classified in class 560, subclass 124+.

Claims 66-72 and 82-86 will be examined as commensurate in scope with the group elected.

Should the applicants wish to elect an invention which is not enumerated above, then they are invited to elect a specific, exemplified species or specific members of variables. With the election of such a compound, the examiner will identify a generic concept inclusive of such species or members and construct an inventive group for examination.

***Distinctness***

The inventions are distinct, each from the other because of the following reasons: the inventions of Groups I-VII are distinct, each from the other, because they differ in structure and/or element so as to be patentably distinct and a prior art reference anticipating but one of the groups would not render obvious the other groups under 35 U.S.C. 103. Groups I-VII are unrelated because divergent classes of compounds exist (M.P.E.P. 806.04(f)), and each group of compounds is capable of supporting its own patent.

Inventions of Groups I-VII and XI are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as active ingredients in antibacterial derivative compounds such as taught in U.S. 5,164,402, and the inventions are deemed patentably distinct

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since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions of Groups I-VII and VIII-X and XII are related as process of making and product made, and inventions of Groups VIII-X and XII and Group XI are related as intermediates utilized in various processes. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, similar products can be made by processes as taught in U.S. 5,633,388.

Inventions of Groups VIII, IX, X and XII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are mutually exclusive processes.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for any of Groups I-XII is not required for any other of the same Groups I-XII, restriction for examination

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purposes as indicated is proper. In addition, it would be an undue burden on the examiner to search all of the inventions in this application.

***Telephone Election***

A telephone call was not made to Attorney Philip I. Datlow on July 20, 2000, to request an oral election to the above restriction requirement based on the numbers of groups.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

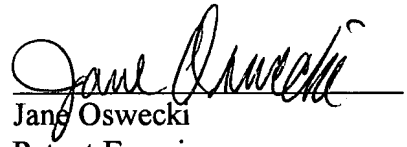
***Telephone Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Oswecki whose telephone number is (703)305-7152. The examiner can normally be reached Monday through Thursday from 7:30 AM to 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703)308-4537. The telephone number for this Group is (703)308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1235.

  
Jane Oswecki  
Patent Examiner  
Art Unit 1626

20 July 2000